

REMARKS

Claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56** were pending in this application. According to the November 3, 2006 Final Office Action, claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56** were rejected.

We have amended independent claims **1, 12, and 47** and dependent claims **9, 20, 24, 27-32, 39-43, 48-51, and 56**. We have cancelled dependent claim **25**. The amendments do not introduce any new matter.

Accordingly, independent claims **1, 12, and 47**, and dependent claims **2-4, 9-10, 13-15, 20-21, 24, 27-46, and 48-56** are under consideration.

Response to the Rejection of Claims under 35 U.S.C. § 112

The Examiner rejected previously presented claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56** under 35 U.S.C. § 112, first paragraph, characterizing the rejection as the claims “containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” We respectfully disagree. Nonetheless, to expedite prosecution of this application, we have amended independent claims **1, 12, and 47**, and have amended dependent claims **9, 20, 24, 27-32, 39-43, 48-51, and 56** in view of the changes to claims **1, 12, and 47**. We have also cancelled dependent claim **25** in view of the changes to claim **1**.

We respectfully submit that amended claims **1-4, 9-10, 12-15, 20-21, 24, and 27-56** are supported by the specification. In particular, with respect to independent claim **1** (and similarly, independent claims **12** and **47**), the specification discloses at page 9, line 9 to page 10, line 10, at page 24, line 3 to page 25, line 17, and in Figures 2 and 15-16, for example, “*accumulating values of trades by a counterparty in a trading market to obtain an accumulated position for the counterparty*,” discloses at page 10, line 11 to page 12, line 15, at page 21, line 19 to page 22, line 30, and in Figures 2 and 12-13, for example, “*comparing the accumulated position for the counterparty with a trading limit assigned against the counterparty for the trading market*,” and discloses at page 4, lines 10-25, at page 10, line 11 to page 12, line 15, at page 21, line 19 to page 22, line 30, at page 24, line 3 to page 25, line 17, and in Figures 2, 12-13, and 15-16, for

example, “*shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit.*”

In view of the foregoing, we respectfully request withdrawal of the rejection of the claims under 35 U.S.C. § 112, first paragraph.

Response to the Rejection of Claims under 35 U.S.C. § 103(a)

The Examiner rejected previously presented claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56** under 35 U.S.C § 103(a) as being unpatentable over May, U.S. Patent No. 6,317,727 (hereinafter May) in view of Wiseman, U.S. Patent No. 5,168,446 (hereinafter Wiseman).

We respectfully submit that the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103(a) with respect to previously presented claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56**. Specifically, to establish a *prima facie* case of obviousness, the Examiner has the burden of showing, in part, that there is “some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ... to combine reference teachings.” (MPEP § 2143). Notably, a conclusory statement as to the factual question of motivation must be supported by evidence of record and without such evidence, lacks substantial evidence support and is thereby insufficient to establish a *prima facie* case of obviousness. In re Lee, 277 F.3d 1338, 1343-1345 (Fed. Cir. 2002).

In the Office Action, the Examiner appeared to assert that in view of Wiseman, “it would have been obvious to one of ordinary skill in the art [to modify the teachings of May] to enable trading for the counterparty when the counterparty and other counterparties exceeds one trading limit due to credit limits to temporary suspend a trade.” First, we respectfully submit that it is unclear what the Examiner means to both “enable trading” and “to temporary suspend a trade.” Second, regardless of the clarity of the Examiner’s statement, the statement is merely conclusory as to the suggestion or motivation to modify May in view of Wiseman and the Examiner presented no evidence of record to support this conclusory statement. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to previously presented claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-56** over May in view of Wiseman.

We also submit that with respect to at least previously presented claims **29-35, 41-45, and 48-52**, the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103(a)

for additional reasons. Specifically, to establish a *prima facie* case of obviousness, the Examiner also has the burden of showing, in part, that the prior art references when combined “teach or suggest all the claim limitations.” (MPEP § 2143). In the Office Action, the Examiner merely indicated that with respect to claims **9-35, 41-45, 48-52**, “May and Wiseman teach a method as claimed in claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-28** ... [and] [t]herefore the rationale applied in the rejections of claims **1-4, 9-10, 12-15, 20-21, 24-25, and 27-28** applies herein.” We note that claims **29-35, 41-45, 48-52** recite limitations not recited by claim **1-4, 9-10, 12-15, 20-21, 24-25, and 27-28**. As such, the Examiner has failed to show that May and Wiseman when combined “teach or suggest all the claim limitations” of claims **29-35, 41-45, 48-52**. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these claims.

We also respectfully submit that neither May nor Wiseman, alone or in combination, teach, suggest, or disclose any of amended claims **1-4, 9-10, 12-15, 20-21, 24, and 27-56**.

Specifically, amended independent claim **1** recites a method, comprising:

accumulating values of trades by a counterparty in a trading market to obtain an accumulated position for the counterparty;

comparing the accumulated position for the counterparty with a trading limit assigned against the counterparty for the trading market; and

shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit.

May discloses a trading system in which “each ... counterparty ... provides ... detailed credit preferences for each potential counterparty.” Thereafter, the “credit preferences inputted by [a] counterparty with regard to [another] counterparty are referenced to determine the trade eligibility of either party with respect to the other for a particular financial transaction instrument.” As May further discloses, a party may view “all the orders ... available on a particular financial instrument” and based on the credit preferences, view the “relevant credit status” of each order and “execute a trade directly if the credit preferences of both parties permit.” (May, column 5, lines 49-62; column 45, lines 45-65; column 47, line 39 to column 48, line 43). Accordingly, May discloses a system whereby trade eligibility is managed between

pairs of counterparties based on credit preferences inputted by one counterparty with regard to another counterparty and as such, May does not teach, suggest, nor disclose “*a trading limit assigned against [a] counterparty for [a] trading market*” and does not teach, suggest, nor disclose “*shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit,*” as claim 1 recites.

Wiseman discloses a system whereby a “Trader Profile” is created “for each of the traders that will use the system at [a] subscriber site.” A trader may “suspend trading and alter the Trader’s Profile or review completed transactions.” Wiseman further discloses, for example, that “a trader [may] ... contact another subscriber ... to request a quotation.” “The trader can optionally designate an amount in the quote request. The system checks to see if this amount is within a predesignated range that is stored in the trader's profile for the selected transaction. If the amount is not within the predesignated range, the trader is requested to confirm the amount before the quote request is transmitted.” (Wiseman, column 2, lines, 30-37; column 3, lines 6-23; column 9, lines 1-12; column 13, lines 26-36). Contrary to claim 1, “a predesignated range” as disclosed by Wiseman is not “*a trading limit assigned against [a] counterparty for [a] trading market,*” as recited by claim 1. In addition, “suspend[ing] trading [to] alter the Trader’s Profile or review completed transactions” as disclosed by Wiseman is not “*shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit,*” as recited by claim 1. As such, Wiseman does not teach, suggest, nor disclose “*a trading limit assigned against [a] counterparty for [a] trading market;* and *shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit,*” as claim 1 recites.

Accordingly, because May and Wiseman each fails to teach, suggest, or disclose “*a trading limit assigned against [a] counterparty for [a] trading market;* and *shutting off, for the counterparty, an ability to trade in the trading market when the accumulated position for the counterparty exceeds the trading limit,*” as claim 1 recites, the combination of May and Wiseman also fails to teach, suggest, or disclose claim 1, in addition to claims 2-4, 9-10, 24, and 29-40, which depend there from.

Turning to amended independent claim 12, this claim recites limitations similar to claim 1 and as such, we submit that May and Wiseman also fail to teach, suggest, or disclose claim 12,

in addition to claims **13-15**, **20-21**, **27-28**, and **41-46** which depend there from, for the same reasons set forth above for claim **1**.

Turning to amended independent claim **47**, this claim recites a method comprising:

accumulating a value of a conducted trade by a counterparty with values of trades previously conducted by the counterparty to obtain an accumulated position for the counterparty;

comparing the accumulated position for the counterparty with a trading limit assigned against the counterparty; and

shutting off, for the counterparty, an ability to trade when the conducted trade causes the accumulated position for the counterparty to exceed the trading limit.

We respectfully submit that neither May nor Wiseman, alone or in combination, teaches, suggests, or discloses amended claim **47**. Specifically, May discloses a system in which prior to a trade for a particular financial transaction instrument, “credit preferences inputted by [a] counterparty with regard to [another] counterparty are referenced to determine the trade eligibility of either party with respect to the other for [the] particular financial transaction instrument.” “Indication of whether a counterparty can enter into the proposed trade is [then] conveyed to the respective trader.” (May, column 5, lines 49-62; column 45, lines 45-65; column 47, line 39 to column 48, line 43). Accordingly, May discloses a system whereby for a particular financial transaction instrument, credit preferences are referenced prior to a trade being conducted to determine the trade eligibility of the parties and as such, May does not teach, suggest, nor disclose “*accumulating a value of a conducted trade ...to obtain an accumulated position for the counterparty*” and then “*shutting off, for the counterparty, an ability to trade when the conducted trade causes the accumulated position for the counterparty to exceed the trading limit,*” as claim **47** recites.

With respect to Wiseman, as similarly discussed above for claim **1**, “suspend[ing] trading [to] alter the Trader’s Profile or review completed transactions” as disclosed by Wiseman is not “*shutting off, for the counterparty, an ability to trade when the conducted trade causes the accumulated position for the counterparty to exceed the trading limit,*” as recited by claim **47**. Accordingly, Wiseman does not teach, suggest, nor disclose such limitations.

As such, because May and Wiseman each fails to teach, suggest, or disclose “*shutting off, for the counterparty, an ability to trade when the conducted trade causes the accumulated position for the counterparty to exceed the trading limit,*” as claim 47 recites, the combination of May and Wiseman also fails to teach, suggest, or disclose claim 47, in addition to claims 48-56, which depend there from.

Conclusion

Since May and Wiseman fail to teach or suggest the present invention as now set forth in claims 1-4, 9-10, 12-15, 20-21, 24, and 27-56, we submit that these claims are clearly allowable. Favorable reconsideration and allowance of these claims are therefore requested.

We earnestly believe that this application is now in condition to be passed to issue, and such action is also respectfully requested. However, if the Examiner deems it would in any way facilitate the prosecution of this application, the Examiner is invited to telephone our undersigned representative at 212-294-7733.

Respectfully submitted,

/Glen R. Farbanish/

February 15, 2007
Date

Glen R. Farbanish
Reg. No. 50,561
Attorney for Applicants